

REMARKS/ARGUMENTS

Amendments

The claims are modified in the amendment. More specifically, claims 8 and 21 have been amended and claim 10 has been cancelled. No new claims have been added. Therefore, claims 1-9 and 11-26 are present for examination. Applicant respectfully requests reconsideration of this application as amended.

Allowable Subject Matter

Applicant notes with appreciation that claims 7, 10, 12, 15, 20, 23-24 and 26 would be allowed if rewritten in independent form. Claims 8 has been amended to include the subject matter of claim 10 indicated to be allowable. Similarly, claim 21 has been amended to include subject matter from claim 10 indicated to be allowable. Therefore, the rejections of claim 8 and its dependent claims 9-12 and claim 21 and its dependent claims 22-26 are rendered moot and will not be addressed below. The Applicant believes, for at least the reasons stated below, that additional allowable matter is present in the pending claims.

35 U.S.C. §102 Rejection, Soltesz et al.

The Office Action has rejected claims 1-6, 8-9, 11, 13, 16-19, 21-22 and 25 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent Publication No. 2001/0011680 of Soltesz et al. (hereinafter "Soltesz"). The Applicant respectfully submits the following arguments pointing out significant differences between claims 1-6, 13, and 16-19 submitted by the Applicant and Soltesz.

Soltesz is directed to "a kiosk of the type capable of handling commercial transactions with full verification of the identity of the user" (para. 3, lines 1-3) and separately,

"a kiosk equipped to provide self-service registration and dispensing of optical memory cards having stored thereon authentication information." (para. 4, lines 1-5) The first kiosk is "a self-service kiosk with a biometrics reader device for obtaining biometrics data from a customer present at the kiosk, a second reader device for inputting biometrics data stored on a portable storage means carried by the user, and circuitry, software, or a combination of circuitry and software for comparing the customer input biometrics data with the stored biometrics data and authorizing a transaction based on the results of the transaction." (para. 14) The second kiosk is "a self-service kiosk with an image capture device and/or a biometrics reader device for obtaining biometrics data from a registrant present at the kiosk, a data input device arranged to enable the registrant to enter registration information, a device arranged to store an image of the registrant and/or other biometrics data on a memory card or other portable data storage medium, and a dispenser for dispensing the memory card or other portable data storage medium to the registrant." (para. 19)

That is, Soltesz teaches a first type of kiosk for reading biometric information from an optical card and verifying the user's identity and a second, separate type of kiosk for obtaining biometrics data and registration information from a registrant and writing that information to an optical card. However, Soltesz does not disclose a system that does both, reading and writing. Rather, Soltesz clearly intends the kiosk to be separate since, if the first kiosk were adapted to read the biometrics data and registration information from a registrant, there would be no need for the optical card.

Claim 1, upon which claims 2-6 depend and claim 13, upon which claims 16-19 depend both recite in part "an optical drive adapted for reading and writing to the optical card." Soltesz does not disclose a single system with an optical drive adapted for reading **and** writing to the optical card. Rather, Soltesz discloses two **separate** kiosks, one for reading an optical card and one for writing. For at least these reasons, claims 1-6, 13, and 16-19 should be allowed.

35 U.S.C. §103 Rejection, Soltesz in view of Soltesz '401.

The Office Action has rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Soltesz in view of the cited portions of U.S. Patent No. 5,027,401 of Soltesz (hereinafter "Soltesz '401"). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j).

As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation. The Office Action does not provide evidence that the suggestion or motivation to modify or combine the references cited is explicit or implicit in the references cited. Further, the Office Action does not provide any evidence that knowledge of one skilled in the art would provide the suggestion or motivation to modify these references. Finally, the Office Action does not provide evidence of a reasonable expectation of success of such a modification or combination.

As discussed above, Soltesz does not teach or suggest a system that does both, reading and writing. Rather, Soltesz teaches two **separate** kiosks, one for reading an optical card and one for writing. Similarly, Soltesz '401 also teaches two separate systems, one for recording information on a card (FIG. 1 and col. 2, line 50 - col. 3, line 30) and one for reading the information (FIG. 3 and col. 3, lines 59-68).

Claim 13, upon which claim 14 depends recites in part "an optical drive adapted for reading and writing to the optical card." Neither Soltesz nor Soltesz '401, alone or in

Appl. No. 10/726,971
Amdt. dated July 20, 2005
Reply to Office Action of April 21, 2005

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combination, teach or suggests a system that does both, reading and writing. For at least these reasons, claim 14 should be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 303-571-4321
WJD/sbm
60482573 v1